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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/776,204      | 02/02/2001  | Morimichi Watanabe   | 06756.006001        | 7075             |

22511 7590 05/10/2004

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1221 MCKINNEY STREET  
HOUSTON, TX 77010

EXAMINER

HORTON, YVONNE MICHELE

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3635

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/776,204

Applicant(s)

WATANABE ET AL.

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 2 and 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite and incomplete for not claiming or citing any method steps.

Accordingly, a method is being claimed in the preamble, there are not any steps associated therewith. Such an omission amounts to only claiming of the apparatus. Hence, although a method of fastening is defined the only required step is "inserting the engaging tongue of the fixture ...into the engaging region...". The applicant should consider revising his verb tense to include the suffix "ing" such as "disposing", "assembling", "attaching", "placing", etc. Further, without there being any method steps recited, it is not clear what the building boards are being "assembled in advance" to. Clarification and correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 2 and 12-14 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by US Patent #5,301,484 to JANSSON. Regarding claims 2 and 12, JANSSON discloses the method of fastening a building board (1) to a framework of a building including the step of inserting an engaging tongue (29) of a fixture (colored blue) attached to the rear surface of a second building board (1) into an engaging region (25) formed in the fixture (colored red) of the first building board (1) such that the building board (1) having a flat configuration and provided on the rear surface thereof with engaging protrusions ((PT), and the fixture (colored blue) is an elongated fixture which is adapted to be detachably engaged with the engaging protrusions (colored red) wherein said fixture (colored blue) is constructed to have a main body as at (22) which is designed to be entirely or partially contact the rear surface of a building board and has engaging holes (6) formed in the main body (22); a rising portion (RP) formed at one end in the longitudinal direction of the main body (22); an extension portion (EP) extending from the distal edge of slid rising portion (RP) in a direction away from and parallel with said main body (22); an engaging region formed between the extension portion (EP) and the rising portion (RP); and the engaging tongue (29) is formed at the other end in the longitudinal direction of the main body (22); wherein said engaging tongue (29) is positioned and shaped such that it can be inserted into said engaging region (25) of the fixture (colored blue) attached to a neighboring building board (1) as a couple of building boards (1) are positioned in a vertical direction so as the first building board (1) is disposed at a lower level than the second building board (1) and the second building board (1) is placed along the upper horizontal edge of said first building

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board (1) by fastening (5), see the marked attachment. In reference to claim 13, the fixture (colored blue) is fixed to the rear surface of the building board (1) with at least the extension portion (EP) thereof being protruded from the peripheral edge of the building board (1). Regarding claim 14, plurality of said fixtures (colored blue) are fixed to the rear surface of said building board (1) at predetermined intervals in conformity with vertical members of a building.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,301,484 to JANSSON. JANSSON discloses the basic claimed method except for explicitly detailing that the building board is material ceramic. In reference to claim 16, the building board (1) of JANSSON can be made from stone or concrete, column 2, line 39-40. Although JANSSON does not explicitly disclose a ceramic

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material it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability as an obvious matter of design choice. Hence, glass building boards might be used in building such as greenhouses that require a great deal of external light and ceramic boards might be used for office buildings that may not require as much external lighting.

***Allowable Subject Matter***

Claims 15 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

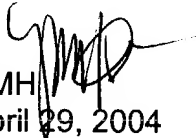
  
YMH  
April 29, 2004

Fig. 5

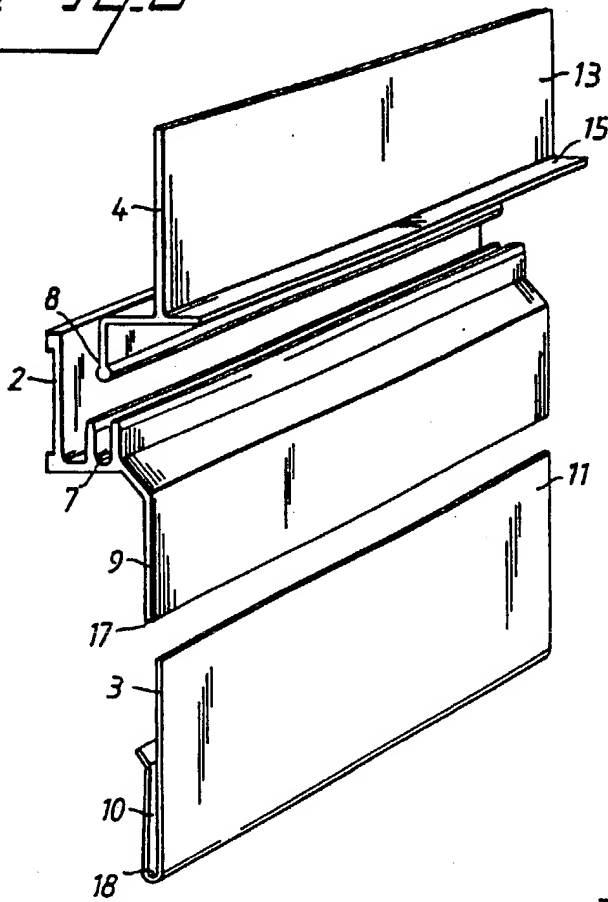


Fig. 6

